

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Valerie Kucharewski et al.	Art Unit	: 2145
Serial No.	: 10/715,215	Examiner	: Ajay M. Bhatia
Filed	: November 18, 2003	Conf. No.	: 2245
Title	: PEOPLE LISTS		

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

BRIEF ON APPEAL

**(1) Real Party in Interest**

AOL LLC, formerly known as America Online, Inc., is the real party in interest.

**(2) Related Appeals and Interferences**

There are no related appeals or interferences.

**(3) Status of Claims**

Claims 1-20 are pending, with claims 1, 19, and 20 being independent. All pending claims have been rejected, and all pending claims are being appealed.

**(4) Status of Amendments**

All amendments have been entered. Most recently, claim 6 was amended in appellant's Amendment in Reply to Action of August 20, 2007, which was filed on October 22, 2007. According to the Advisory Action mailed on November 15, 2007, the amendment to claim 6 has been entered.

**(5) Summary of Claimed Subject Matter**

Independent claim 1 is directed to a method for enabling management of contacts. As recited in independent claim 1, a set of contacts that, as a group, repeatedly are sent communications by a member are passively recognized. See, e.g., Application at page 3, lines 27-30 and page 13, lines 7-26. Thereafter, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member is

identified to the member, and a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group is generated. See, e.g., Application at page 14, lines 4-6 and page 15, lines 1-9. The member also is enabled to associate a name with the contacts list and to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list. See, e.g., Application at page 14, lines 4-6 and page 15, lines 1-9.

Independent claim 19 is directed to an apparatus that includes a computer readable medium that has instructions stored thereon that, when executed by a machine, result in a number of acts being performed. Specifically, the computer readable medium includes instructions for passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. See, e.g., Application at page 3, lines 27-30; page 13, lines 7-26; and page 21, line 24 to page 22, line 11. In addition, the computer readable medium includes instructions for identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group. See, e.g., Application at page 14, lines 4-6; page 15, lines 1-9; and page 21, line 24 to page 22, line 11. The computer readable medium also includes instructions for enabling the member to associate a name with the contacts list and enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list. See, e.g., Application at page 14, lines 4-6; page 15, lines 1-9; and page 21, line 24 to page 22, line 11.

Independent claim 20 is directed to a system for enabling management of contacts. As recited in independent claim 20, the system includes means for passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. See, e.g., Application at page 3, lines 27-30; page 13, lines 7-26; and page 21, line 20 to page 22, line 11. In addition, the system includes means for identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member and means for generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group. See, e.g., Application at page 14, lines 4-6; page 15, lines 1-9; and page 21, line 20 to page 22, line 11.

The system also includes means for enabling the member to associate a name with the contacts list and means for enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list. See, e.g., Application at page 14, lines 4-6; page 15, lines 1-9; and page 21, line 20 to page 22, line 11.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The final Office Action states that claims 1-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,247,043 (Bates). The final Office Action also states that claims 10 and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates in view of U.S. Patent Application Publication No. 2004/0003071 (Mathew). All of the pending rejections are being appealed.

**(7) Argument**

Appellants challenge the rejection of each of claims 1-20 at least because the final Office Action fails to properly communicate the basis for rejecting claims 5, 6, 10, 11, 17, and 18 and because none of Bates, Mathew, or any combination of the two describes or suggests all of the features recited in independent claims 1, 19, and 20.

*A. The Final Office Action Fails to Properly Communicate the Basis for Rejecting Claims 5, 6, 10, 11, 17, and 18*

Initially, the final Office Action states:

[c]laims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bates (US 6247043).

Final Office Action of August 20, 2007 at page 2, lines 14-15. However, as discussed more fully below, the final Office Action provides no explanation for the rationale underlying the rejection of at least one of claims 5 and 6 and the final Office Action also seems to indicate that claims 10, 11, 17, and 18 are rejected exclusively under 35 U.S.C. § 103(a) as being obvious over Bates in view of Mathew.

At first blush, the final Office Action does not appear to include any grounds of rejection for claim 6. In particular, the final Office Action appears to address claim 5, skip claim 6, and

then address claim 7. See final Office Action of August 20, 2007 at page 4, lines 8-15.

However, closer examination of the final Office Action reveals that the grounds of rejection purportedly set forth for claim 5 do not address the features recited in claim 5 but, rather, appear to address the features recited in claim 6. See final Office Action of August 20, 2007 at page 4, lines 8-9.

Specifically, the grounds of rejection for claim 5 set forth by the final Office Action state:

[f]or claim 5, Bates teaches, the method of claim 4 further comprising enabling the member to assign a unique identifier to the [sic] contacts list.

Final Office Action of August 20, 2007 at page 4, lines 8-9 (emphasis added). The features referenced in this excerpted passage of the final Office Action appear directed to the features recited in claim 6, which recites that the method of claim 1 further comprises “enabling the member to assign a unique identifier to the contacts list” (emphasis added), without addressing the features recited in claim 5, which recites that the method of claim 4 further comprises “enabling the member to delay the generation of a rejected contacts list.”

Appellants noted the confusion caused by the final Office Action’s treatment of claims 5 and 6 in appellants’ Amendment in Reply to Action of August 20, 2007, filed on October 22, 2007. See, e.g., Amendment in Reply to Action of August 20, 2007 of October 22, 2007 at page 7, line 16 to page 8, line 9. However, appellants have not received any further articulation of the grounds of rejection of claims 5 and 6. As such, appellants assume that the grounds of rejection purportedly set forth for claim 5 actually apply to claim 6, leaving appellants with no understanding of under what grounds claim 5 has been rejected.

Furthermore, although the final Office Action initially states that each of claims 1-20 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Bates, the final Office Action does not set forth any grounds of rejection under 35 U.S.C. § 102(b) for claims 10, 11, 17, and 18. Rather, after setting forth grounds of rejection for claims 1-5, 7-9, 11<sup>1</sup>-16, 19, and 20 under 35 U.S.C. § 102(b), the final Office Action states:

---

<sup>1</sup> Appellants note that although the grounds of rejection set forth for claim 11 in the final Office Action appear under the heading “*Claim Rejections – 35 USC § 102*,” the grounds of rejection set forth for claim 11 appear to rely on a combination of Bates and Mathew. See final Office Action of August 20, 2007 at page 5, lines 4-6. This suggests that claim 11 has been rejected under 35 U.S.C. § 103(a), not under any of the subsections of 35 U.S.C. § 102.

[c]laims 10-11 [are] rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of Mathew (US 2004/0003071).

Final Office Action of August 20, 2007 at page 8, lines 8-9. In addition, the final Office Action sets forth grounds of rejection for claims 10 and 11, as well as claims 17 and 18, that appear to rely on the combination of Bates and Mathew. See final Office Action of August 20, 2007 at page 8, lines 10-19; page 5, lines 4-6; and page 9, line 1 to page 10, line 7.

Appellants noted the confusion surrounding the grounds of rejection for claims 10, 11, 17 and 18 in appellants' Amendment in Reply to Action of August 20, 2007, filed on October 22, 2007. See, e.g., Amendment in Reply to Action of August 20, 2007 of October 22, 2007 at page 8, lines 11-21. Unfortunately, the Advisory Action of November 15, 2007 failed to clarify the grounds of rejection for claims 10, 11, 17, and 18, stating only that:

[c]laims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bates (US 6247043) . . . .

Advisory Action of November 15, 2007 at Continuation Sheet line 4.

Because the final Office Action and the Advisory Action each explicitly state that claims 1-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bates, while seemingly relying exclusively on other grounds of rejection for claims 10, 11, 17, and 18 (i.e., the combination of Bates and Mathew), appellants' Pre-appeal Brief Request for Review filed on December 20, 2007 requested (1) reopening of prosecution, or, at a minimum and in the alternative, (2) clear articulation of the grounds relied upon in rejecting each of pending claims 1-20 to enable appellants (and the Board of Patent Appeals) a clear understanding of the pending rejections. However, no clarification of the grounds for rejection of each of pending claims 1-20 ever was provided.

Nevertheless, putting aside the confusion surrounding claims 5 and 6 that was discussed above, because the grounds of rejection set forth in the final Office Action for claims 1-4, 7-9, 12-16, 19, and 20 appear to rely only on Bates and because the grounds of rejection set forth in the final Office Action for claims 10, 11, 17, and 18 appear to rely on the combination of Bates and Mathew, at least with respect to claims 1-4 and 7-20, appellants understand claims 1-4, 7-9, 12-16, 19, and 20 as having been rejected under 35 U.S.C. § 102(b) as being anticipated by

Bates, and claims 10, 11, 17, and 18 as having been rejected under 35 U.S.C. § 103(a) as being obvious over Bates in view of Mathew.

*B. None of Bates, Mathew, or Any Combination of the Two Describes or Suggests All of the Features Recited in Independent Claims 1, 19, and 20*

Independent claim 1 recites a method for enabling management of contacts that includes, among other features, passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member. Bates does not describe these features of independent claim 1. Accordingly, appellants request reversal of the rejection of independent claim 1 and its dependent claims, claims 2-18.

The final Office Action contends that Bates discloses passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member at col. 15, lines 42-57. See final Office Action of August 20, 2007 at page 2, lines 17-18. However, this assertion is incorrect.

When read in the context of its surrounding paragraphs, it is clear that col. 15, lines 42-47 of Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. Rather, this passage from Bates discloses, at most, determining whether a first individual user has exchanged more than a threshold number of communications with a second individual user, and, if so, adding the second individual user to the first individual user's local contacts database:

[The automated addition of entries] is typically performed in response to an accumulation of contacts between a pair of users exceeding a predetermined threshold. . . .

Auto-add entry routine **152** is passed as input the user name being processed by update contact routine **142**. . . .

Routine **152** begins in block **180** by determining whether the count field for the entry in the contact table corresponding to the user name passed to the routine exceeds a predetermined

threshold. If it does not, no further processing is required, and the routine **152** terminates. If the count field is greater than the threshold, however, control passes to block **182** to determine whether or not the user name passed to the routine has an entry in the local contact database for the local user. If such an entry already exists, no further processing is required, and routine **152** terminates. However, if no such entry exists, control passes to block **184** to add an entry in the local contact database for the user by copying the corresponding entry from the master contact database. . . .

After an entry is created in the local database, processing is complete, and routine **152** terminates.

The predetermined threshold with which the count field for a user is compared may be set to any number of values to control the frequency at which new entries are added to the local database via routine **152**. It will be appreciated that, the higher the threshold, the more contacts are required between any pair of users prior to addition of a new entry to the local contact database. It should be appreciated that, rather than using a composite count, separate counts may be maintained for different contact types, whereby each count type could be compared to a separate threshold, and an entry created if any one count exceeds its corresponding threshold.

Bates at col. 15, lines 5-57 (emphasis added).

As the paragraphs excerpted above clearly reveal, col. 15, lines 42-57 of Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. Rather, as is evident by the repeated use of the terms “user name” and “user,” this portion of Bates describes determining whether the number of communications exchanged between a first individual user and another individual user exceeds a predetermined threshold, and, if so, adding the second individual user to the first individual user's local contacts database.

Importantly, this portion of Bates does not describe or suggest repeatedly sending communications to a set of contacts as a group, nor does this portion of Bates describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. Consequently, the final Office Action's assertion

that the referenced portion of Bates teaches passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member is incorrect.

The final Office Action also incorrectly contends that Bates discloses generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1. As discussed above, Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. Consequently, Bates also fails to describe or suggest generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1.

For at least the foregoing reasons, appellants submit that Bates fails to describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1. Accordingly, appellants request reversal of the rejection of independent claim 1 and its dependent claims, claims 2-18.

Independent claims 19 and 20 recite features that are similar to those discussed above in connection with independent claim 1, and do so in the context of an apparatus (claim 19) and a system (claim 20). Accordingly, appellants request reversal of the rejection of independent claims 19 and 20 for at least the reasons discussed above in connection with independent claim 1.

The brief fee of \$510 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

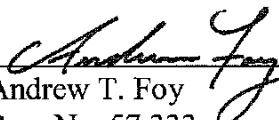


Applicant : Valerie Kucharewski et al.  
Serial No. : 10/715,215  
Filed : November 18, 2003  
Page : 9 of 15

Attorney's Docket No.: 06975-472001

Respectfully submitted,

Date: May 5, 2008

  
\_\_\_\_\_  
Andrew T. Foy  
Reg. No. 57,333

Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (202) 783-2331

40491455

### **Appendix of Claims**

1. (Previously presented) A method for enabling management of contacts, the method comprising:

passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member;

identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member;

based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group;

enabling the member to associate a name with the contacts list; and

enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list.

2. (Previously presented) The method of claim 1 wherein passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member comprises:

storing communications sent by the member during a period of time;

examining the communications sent by the member during the period of time; and

identifying that the set of contacts was sent at least a minimum number of communications by the member during the period of time.

3. (Previously presented) The method of claim 1 wherein passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member comprises:

storing a predetermined number of communications sent by the member;

examining the predetermined number of communications sent by the member; and

identifying that the set of contacts was sent at least a minimum number of communications out of the predetermined number of communications by the member.

4. (Previously presented) The method of claim 1 further comprising enabling the member to accept or to reject the generation of the contacts list.

5. (Previously presented) The method of claim 4 further comprising enabling the member to delay the generation of a rejected contacts list.

6. (Previously presented) The method of claim 1 further comprising enabling the member to assign a unique identifier to the contacts list.

7. (Previously presented) The method of claim 1 wherein enabling the member to address future communications to the set of contacts through use of the name associated by the member with the list of contacts comprises enabling the member to address future communications to the set of contacts from multiple applications through the use of the name associated by the member with the list of contacts.

8. (Original) The method of claim 7 wherein the multiple applications include communications applications.

9. (Original) The method of claim 8 wherein the communications applications include an e-mail application and at least one application other than an e-mail application.

10. (Original) The method of claim 8 wherein the communications applications include an instant messaging application and at least one application other than an instant messaging application.

11. (Original) The method of claim 8 wherein the communications applications include a digital image sharing application and at least one application other than a digital image sharing application.

12. (Original) The method of claim 8 wherein the communications applications include an alerting application that sends alerts and reminders to users and at least one application other than an alerting application that sends alerts and reminders to users.

13. (Original) The method of claim 8 wherein the communications applications include an application for sharing and exchanging contact information and at least one application other than an application for sharing and exchanging contact information.

14. (Original) The method of claim 7 wherein the multiple applications include other sharing applications.

15. (Original) The method of claim 14 wherein the other sharing applications include an electronic calendar application and at least one application other than an electronic calendar application.

16. (Original) The method of claim 14 wherein the other sharing applications include an electronic journal application and at least one application other than an electronic journal application.

17. (Original) The method of claim 14 wherein the other sharing applications include an e-mail filtering application and at least one application other than an e-mail filtering application.

18. (Original) The method of claim 14 wherein the other sharing applications include an application that enables the specification of parental controls over a child account and at least one application other than an application that enables the specification of parental controls over a child account.

19. (Previously presented) An apparatus comprising a computer readable medium having instructions stored thereon that when executed by a machine result in at least the following:

passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member;

identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member;

based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group;

enabling the member to associate a name with the contacts list; and

enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list.

20. (Previously presented) A system for enabling management of contacts comprising:  
means for passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member;

means for identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member;

means for generating a contacts list that includes the set of contacts based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, the contacts list being useful in addressing future communications to the set of contacts as a group;

means for enabling the member to associate a name with the contacts list; and

means for enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list.

Applicant : Valerie Kucharewski et al.  
Serial No. : 10/715,215  
Filed : November 18, 2003  
Page : 14 of 15

Attorney's Docket No.: 06975-472001

### **Evidence Appendix**

None.

Applicant : Valerie Kucharewski et al.  
Serial No. : 10/715,215  
Filed : November 18, 2003  
Page : 15 of 15

Attorney's Docket No.: 06975-472001

### **Related Proceedings Appendix**

None.